

REMARKS

I. OVERVIEW

Claims 13 and 15-22 will be pending in the present application upon entry of this amendment. Claims 13, 21, and 22 have been amended. Claim 14 has been canceled. The issues raised by the Examiner in the Non-Final Office Action of December 20, 2006 (*Office Action*) are as follows:

- The Information Disclosure Statement of April 23, 2004 is listed as failing to comply with 37 C.F.R. §§ 1.98(a)(2); and
- Claims 13-22 rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,186,181 (*Franconi*).

In response, Applicants respectfully traverse the outstanding claim rejections and requests reconsideration and withdrawal in light of the remarks presented herein.

II. INFORMATION DISCLOSURE STATEMENT

The Information Disclosure Statement (IDS) of April 20, 2004 is listed as failing to comply with 37 C.F.R. §§ 1.98(a)(2). *Office Action* at p. 2. In that IDS, Applicants stated that:

[t]his application is a application of Serial No. 09/616,769 filed March 24, 1998 and issued as U.S. Patent 6,094,599, and is relied upon for an earlier filing date under 35 U.S.C. § 120. In accordance with Rule 37 C.F.R. § 1.98(d) copies of the listed documents are not enclosed as they have been previously cited by or submitted to the Patent and Trademark Office in prior application Serial No. 09/616,769.

IDS of April 20, 2004 at p. 2. Applicants respectfully note that, although the correct U.S. Patent number was cited in the above paragraph, it was associated with the wrong application serial number due to an oversight. U.S. Patent No. 6,094,599 in fact corresponds to 03/046,856 (not 09/616,769). Therefore, copies of the documents listed in the IDS of April 20, 2004 have been previously cited by or submitted in connection with application serial no. 03/046,856. Applicants apologize for the inadvertent mistake. Withdrawal of the objection to the IDS and consideration of the cited references therein are respectfully requested. If there are any questions

or concerns about this issue, the Examiner is cordially invited to contact the undersigned attorney.

III. AMENDMENTS TO THE CLAIMS

Claim 13 has been amended with elements originally recited in canceled claims 6 and 14. Claim 21 has been amended to recite a housing releasably connected to the patient-conforming garment. Claim 22 has been amended to recite a patient-conforming garment elastically deformable to conform to a body part insertable therein. No new matter has been added as the recited features find ample support in the Specification as originally filed. *E.g., Specification* at p. 9, lns. 16-18 and p. 13, lns. 5 and 6.

IV. CLAIM REJECTIONS UNDER 35 U.S.C. § 102(b)

Claims 13 and 15-22 are rejected under 35 U.S.C. § 102(b) as being unpatentable over *Franconi*. *Office Action* at p. 2. Applicants traverse the rejection and asserts that these claims are allowable, at least, for the reasons stated below.

To anticipate a claim under 35 U.S.C. § 102, a single reference must teach each and every element of the claim. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). In fact, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Furthermore, for a reference to be anticipatory, “[its] elements must be arranged as required by the claim.” *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990), *cited in M.P.E.P. § 2131*.

Claim 13, as amended, now recites “a patient-conforming garment . . . ,” “a primary coil incorporated into the patient-conforming garment,” and “a secondary coil incorporated into the patient-conforming garment” Applicants respectfully assert that *Franconi* is silent regarding these claimed features. Applicants further note that *Franconi* requires an extremely high degree of precision in the delivery of its hyperthermic cancer treatment, thus precluding incorporation of its waveguide applicator (HPA) with a patient-conforming garment. *See, e.g., Franconi* at col. 6, lns. 30-34 and lns. 38-45.

Claim 13, as amended, also recites “means for tuning an RF field established by the secondary coil to resonate with a body part insertable into the patient-conforming garment.” The Examiner does not contend that *Franconi* teaches this element, and Applicants assert that it does not. *See Office Action* at p. 2. To the contrary, the Examiner seems to admit that *Franconi* only shows a “tuning means that balances the power source to the external load.” *Id.* There is no indication in *Franconi* of a tuning means for tuning an RF field to resonate with a body part insertable into a patient-conforming garment, as now recited in claim 13.

Therefore, Applicants respectfully submit that *Franconi* does not teach every element of amended claim 13. Dependent claims 15-22 depend from claim 13, thus inheriting all the limitations of that independent claim. As noted above, *Franconi* does not teach every element of independent claim 13. Consequently, *Franconi* also fails to teach every element of dependent claims 15-22. Accordingly, Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 102(b) rejection of record with respect to claims 13 and 15-22.

V. CONCLUSION

Applicants respectfully submit that the present application is in immediate condition for allowance. If there are any questions or concerns, the Examiner is cordially invited to contact the undersigned attorney at 512-536-3005.

Respectfully submitted,



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